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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/155,982	10/09/1998	FREDERIC KLEIN	032475-001	9420

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EXAMINER

PORTNER, VIRGINIA ALLEN

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 09/02/2003

29

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.
09/155,982

Applicant(s)
Klein

Examiner
Portner

Art Unit
1645



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Aug 14, 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on Apr 11, 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment

3. ☐ Applicant's reply has overcome the following rejection(s):

4. ☒ Newly proposed or amended claim(s) 3, 45, 47, 48, 50-52, 54-57, 64, 66, 74 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
all of the arguments are directed to newly proposed claims not entered.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none

Claim(s) objected to: none

Claim(s) rejected: 17-19, 22, 24, 26, 28-31, 33-35, and 37

Claim(s) withdrawn from consideration: 20-21, 23, 25, 27, 30(protein), 32, 36, 38-39

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

10. ☐ Other:

Art Unit: 1645

The following claims would be allowable if submitted separately:

Claim 40-41, 43, 45, 47-48, 50-52, 54-57, 64, 66, 74 and 76.

The following new claims, submitted After Final, raise new issues and have not been entered for at least the following reasons:

- a. All previously examined claims would be canceled and all new claims submitted.
- b. New claim 42 is directed to an isolated monoclonal antibody that need not recognize a 150 kDa T.equigenitalis protein; the claimed monoclonal antibody "can be obtained" from the recited process steps, but is not limited to the recited process steps, therefore the scope of claim 42 is not limited to any specific binding specificity. Claim 42 is not limited to the subject matter previously indicated as defining over the prior art of record, but is directed to any monoclonal antibody that is isolated, and if entered would necessitate new grounds of rejection/consideration and/or search.

Amendment of claim 42 to recite the phrase:

--obtained by the process comprising the steps of --

and deleting the phrase:

[which can be obtained from hybridomas by a method] could define a claim that would be entered After Final and would be allowable.

Art Unit: 1645

c. All claims dependent from claim 42 would not be entered for the same reasons claim 42 is not entered After Final; these claims include 58-63, 65, 67,68,70,75,77-78.

d. Claim 44, though it depends from claim 40 which has been indicated as defining over the prior art of record, is directed to a hybridoma that need only be **capable** of secreting a monoclonal antibody according to claim 40. The hybridoma that has the capability of secreting a monoclonal antibody need not comprise the genetic material that would result in the secretion of a monoclonal antibody, but need only be capable at some point in time of being modified to secrete a monoclonal antibody of claim 40. The invention of claim 44 is not limited to a hybridoma that would secrete the antibody of claim 40; the newly submitted claim raises a new issue After Final.

e. Claim 46 is directed to a method of diagnosis but does not provide a biological sample suspected of containing *Tylorella equigenitalis* antigen, and only detects a reaction of the antigen-antibody type, which may or may not comprise the monoclonal antibody recited in the “bringing” step, and could detect antigen-antibody complexes present in the biological sample produced by the infected animal; the “detecting” step is not correlated with the presence or absence of infection. The term “detecting” lacks antecedent basis in the preamble of the claim, which recites “diagnosis”. Claim 46 would raise new issues After Final upon entry. Additionally claims 69, 71, 72 and 73 would also raise new issues After Final upon entry for the same reasons claim 46 raises new issues as similar claim language is recited in claims 69, 71-73..

f. Claim 53 depends from claim 46 which raises new issues, therefore claim 53 would also raise a new issue After Final if entered.

Art Unit: 1645

g. Claims 49,79-83 are directed to Pharmaceutical compositions which would be subject to new grounds of rejection and consideration if entered After Final (scope of enablement), as applied to pending claim 31.

1.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ginny Portner whose telephone number is (703)308-7543. The examiner can normally be reached on Monday through Friday from 7:30 AM to 5:00 PM except for the first Friday of each two week period.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached on (703) 308-3909. The fax phone number for this group is (703) 308-4242.

The Group and/or Art Unit location of your application in the PTO will be Group Art Unit 1645. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to this Art Unit.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Vgp

August 28, 2003


LYNETTE R. F. SMITH
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